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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,772	08/04/2003	Elinor Isobel Forbes	MS-02/3/US	5121

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EXAMINER	
MUSSELMAN, TIMOTHY A	
ART UNIT	PAPER NUMBER
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/633,772	FORBES ET AL.	
	Examiner	Art Unit	
	Timothy Musselman	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 July 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

In response to the amendment filed 7/7/2006, claims 21-38 are pending. Claims 1-20 have been cancelled.

Allowable Subject Matter

[1] The indicated allowability of claims 24, 26-31, and 33-37, is withdrawn in view of the newly discovered reference(s) to Dondero et al. (US 5,538,432), Castanis et al. (US 3,833,222), Craig (US 4,205,850), and Lowenstein (US 2,076,956). Rejections based on the newly cited reference(s) follow. This action is made NON-FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112;

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as the invention.

Claims 21-28 and 30-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

[2] Claims 21-28 and 30-38 provide for the use of a therapeutic device for cognitive stimulation, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

[3] Claim 24 includes the use of the trademark VELCRO. Since the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name.

Claim Rejections - 35 USC § 101

[4] Claims 21-38 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. In order for an invention to be statutory it must produce a useful, tangible, and concrete result. In the instant case the claims fail to produce a concrete result. In order to be concrete the result must be assured, or substantially repeatable. The claimed limitation of the method providing a "therapeutically beneficial cognitive challenge appropriate to the subject's mental acuity" is not considered a concrete result, as said result cannot be guaranteed in every case due to the large variation of human mental characteristics. There is no guarantee that the claimed result will occur with each individual user of the system. See MPEP 2106. Claims 22-38 are rejected for their incorporation of the above.

Claim Rejections - 35 USC § 103

The following is a quotation of the relevant portion of 35 U.S.C. 103 that forms the basis for the rejections made in this section of the office action;

(a) A patent may not be obtained though the invention is not identically disclosed or

> described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Claims 21-23, 26-29, and 32-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (US 3,726,027) in view of Dondero et al. (US 5,538,432).

[4] Regarding claim 21, Cohen discloses a kit that comprises a plurality of pieces that have surface layers formed collectively of a plurality of soft fabrics that are distinguishable by touch and/or subsurface layers that are distinguishable by touch through a lightweight surface fabric when handled by the subject. See col. 2: 5-10 (kit comprises plurality of pieces), and col. 4: 40-60 (surface layers comprising plurality of soft fabrics). Cohen further discloses wherein said pieces are suitable for arrangement by the subject in a simple assembly or construction pastime, puzzle, or game. See col. 2: 1-50 (assembly/construction process), and col. 5: 1-5 (construction process as pastime). Cohen further discloses wherein said kit has means for engaging said pieces to other such pieces or on a rack, wherein when so engaged the pieces resist accidental disarrangement. See col. 2: 39-47. Cohen fails to teach wherein the device provides a therapeutically beneficial cognitive challenge appropriate to the subject's mental acuity, and further fails to teach wherein the user of the device is an adult subject suffering from a medically diagnosed dementia. However, Dondero discloses a system comprising a frame with attachable surfaces comprising sensory elements of various textures for manipulation by adults with dementia in order to provide a therapeutic cognitive challenge appropriate to the individual's condition. See col. 1: 45-67. It would have been obvious at the time the invention was made to incorporate the teachings of Dondero regarding the therapeutic value of such devices, into the method of Cohen, so as to provide mental stimulus appropriate for a cognitively impaired individual (i.e. an adult with a medically diagnosed dementia).

[5] Regarding claim 22, Cohen further discloses wherein the kit has means for engaging the pieces to other such pieces. See col. 2: 23-27.

[6] Regarding claim 23, Cohen further discloses wherein said engaging means comprises an attaching means in an edge region of each of the pieces, the attaching means not requiring a high level of cognitive and/or manual dexterity. See col. 2: 23-27.

[7] Regarding claim 26, Cohen further discloses wherein the kit comprises a rack, and has means for engaging the pieces at a plurality of loci on the rack. See col. 2: 39-47, and note that the rigid cuboctahedron structure can be considered a rack for the various fabric sheets of this citation, and additionally for the textured materials described in col. 3: 40-60.

[8] Regarding claim 27, Cohen further discloses wherein the rack comprises a frame that defines a shape of an aperture adapted to receive a plurality of the pieces, said plurality of pieces being individually of such sizes and shapes as to fit together to form the shape of the aperture. See col. 2: 40-50.

[9] Regarding claim 28, Cohen further discloses wherein the rack comprises a frame having a plurality of apertures (faces of the cuboctahedron), each adapted to receive one of the pieces. See col. 2: 40-50.

[10] Regarding claim 29, Cohen further discloses wherein the user of the therapeutic device can use said kit to play a simple game. See col. 1: 19-35.

[11] Regarding claim 38, Cohen further discloses wherein said plurality of pieces have surface layers formed collectively of a plurality of soft fabrics that are distinguishable by touch when handled by the subject. See col. 3: 40-60.

[12] Regarding claim 32, Cohen further discloses wherein each of said pieces has opposing surface layers formed of soft fabrics having differing tactility. See col. 4: 1-10. Note that Cohen has described in col. 3: 53-60 that the inner face of a section of the cuboctahedron can be a 'furry rug', and in col. 2: 40-60 that the outer face can be a pile material (e.g. flannel) of a specific color.

[13] Regarding claim 33, Cohen further discloses wherein the soft fabric forming each surface layer of the pieces is independently selected from a group comprising real and simulated furs. See col. 3: 40-60.

[14] Regarding claims 34 and 35, Cohen further discloses wherein at least one soft fabric forming a surface layer is a piliferous fabric. See col. 2: 40-50, and note that flannel is a piliferous material, and it *must* be formed from one or both of either natural or synthetic fibers (as per claim 35).

[15] Regarding claim 36, Cohen further discloses wherein the piliferous fabric is selected from a group comprising flannel. See col. 2: 40-50.

[16] Regarding claim 37, Cohen further discloses wherein the piliferous fabric is a fur or simulation thereof. See col. 3: 50-55.

Claims 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (US 3,726,027) in view of Dondero et al. (US 5,538,432) and in further view of Craig (US 4,205,850).

[17] Regarding claim 24, Cohen/Dondero disclose a system that meets all of the limitations of parent claim 23 as described in paragraph 6 above. Cohen/Dondero fail to teach wherein the attaching means securing the pieces together is selected from a group comprising VELCRO. However, Craig discloses a puzzle type device for developing cognitive skills that teaches of

utilizing VELCRO to fasten pieces together. See col. 1: 45-50. Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention, to incorporate the puzzle piece fastening means of Craig, into the method of Cohen, so as to provide a fast and easy means for connecting pieces of the structure together.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (US 3,726,027) in view of Dondero et al. (US 5,538,432) and in further view of Lowenstein (US 2,076,958).

[18] Regarding claim 25, Cohen/Dondero disclose a system that meets all of the limitations of parent claim 23 as described in paragraph 6 above. Cohen further discloses wherein the pieces can be soft fabric patches, and wherein the kit comprises a plurality of said patches. See col. 3: 50-60. Note that in this case, the fabric elements such as the 'furry rug' are the pieces that are attached to the cuboctahedron frame. Cohen/Dondero fail to teach of the pieces being attachable along an edge thereof to one or more other patches to form a patchwork article. However, Lowenstein teaches of attaching a plurality of pieces along the edges to form decorative patchwork articles. See col. 1: 1-10, and fig. 1. One of ordinary skill in the art at the time of the invention, seeking a decorative type patchwork project, would have found it obvious to incorporate the afore-mentioned features of Lowenstein into the system of Cohen, in order to provide a means of fastening pieces of the assembly together in a decorative manner as sought.

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (US 3,726,027) in view of Dondero et al. (US 5,538,432) and in further view of Castanis (US 3,833,222).

[19] Regarding claims 30 and 31, Cohen/Dondero disclose a system that meets all of the limitations of parent claim 26 as described in paragraph 7 above. Cohen further discloses wherein the pieces attached to the frame can be a swath of soft fabric (claim 31). See col. 3: 40-60.

Cohen/Dondero fail to teach of the rack comprising a plurality of pegs arranged to define a plurality of receiving areas for the pieces, and further fail to teach of said pieces being perforated by a plurality of eyelets in an arrangement adapted to engage the pegs. However, Castanis teaches of a puzzle type device for cognitive development that includes these features. See col. 2: 13-22, and col. 2: 54-61. Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention, to utilize the peg and eyelet method of Castanis, in the method of Cohen, so as to allow the kit to be entirely assembled in only one correct way.

Response to Arguments

[20] Applicants arguments directed to the prior art reference of Sclan et al. (US 5,082,446), and all arguments directed to the lack of teaching of a therapeutically beneficial cognitive challenge, are moot in view of the new grounds of rejection.

Applicant additionally argues that the device of Cohen does not comprise a kit, and that the pieces of Cohen are not 'suitable for arrangement by the subject". Examiner does not find this argument persuasive. Cohen discloses in col. 2: 10-50 and the figures referred to therein, the process wherein the device is constructed from flat-form pieces. Applicant asserts that this construction process is directed to a person other than the subject, and that the subject would only receive the constructed device. To the contrary, Cohen discloses in col. 5: 1-3, that the device can be *constructed* from flat-form by the subjects to teach them how to read and follow directions.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy Musselman whose telephone number is (571)272-1814. The examiner can normally be reached on Mon-Thu 6:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto, can be reached at (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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PRIMARY EXAMINER